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Paper No. 8

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In re Application of: M. Neal et al.
Application No. 09/741,958
Filed: December 20, 2000
For: PRICE OPTIMIZATION SYSTEM

**DECISION ON PETITION
TO MAKE SPECIAL**

This is a decision on the petition, filed April 26, 2001, to make the above-identified application special under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;
- (C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not clearly comply with (B) and (E) above. With respect to (B), while the petition states that an election would be made without traverse if the claims are not directed to a single invention, there is no statement indicating that all the claims presented are directed to a single invention. While the petition includes a statement that "Applicants elect claims 6-13 without traverse" and that the "elected claims" are directed to a single invention, no restriction requirement has been made by the Office to permit an election.

With respect to (E), initially note that claims 1-5 are not discussed with respect to the prior art, apparently due to the asserted "election" of 6-13. The limitations discussed in the petition appearing in claim 6 are not all found in claim 1 and thus there is no clear statement as to why the claimed subject matter is patentable over the references. With respect to the limitations of claim 6 and the references, the discussion of why claim 6 is asserted to be patentable over each of the references employs general statements such as "Carter does not disclose the claimed invention as recited by independent claim 6". Also the discussion of the references as a whole quotes each of the elements of the claim. This does not provide the particularity required by 37 CFR 1.111 (b) and (c). Note, however, that the discussion of Ouimet '893 does include a discussion of particular claim language.

Accordingly, the Petition is **DENIED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

Any request for reconsideration must be filed within two months of the mailing date of this decision.



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